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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO.       |
|--|-------------|----------------------|-------------------------|------------------------|
| 10/728,898   | 12/08/2003  | Hiroshi Ishikawa     | 040302-0361             | 9294                   |
| 22428  | 7590        | 09/24/2007           |                         |                        |
| FOLEY AND LARDNER LLP<br>SUITE 500<br>3000 K STREET NW<br>WASHINGTON, DC 20007 |             |                      | EXAMINER<br>TSOY, ELENA |                        |
|  |             |                      | ART UNIT<br>1762        | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>09/24/2007 | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/728,898

Applicant(s)

ISHIKAWA ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

Amendment filed on August 13, 2007 has been entered. Claims 2-4 have been cancelled. Claims 1, 5-9 are pending in the application. Claims 7-8 are withdrawn from consideration as directed to a non-elected invention.

***Claim Objections***

1. Objection to claims 1 and 9 because of the informalities has been withdrawn due to amendment.

***Specification***

2. Object to the disclosure because of the following informalities has been withdrawn due to amendment.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panush (EP 0148718 A2) in view of Dattilo (US 6,291,018) for the reasons of record set forth in paragraph 5 of the Office Action mailed on 5/11/2007.
5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Panush in view of Dattilo, further in view of Jackson et al (US 5962574) for the reasons of record set forth in paragraph 6 of the Office Action mailed on 5/11/2007.

***Response to Arguments***

6. Applicants' arguments filed August 13, 2007 have been fully considered but they are not persuasive.

(A) Applicants argue that a prima facie case of obviousness has not been established since three basic criteria were not met. Here, Panush, Datillo, and Jackson, whether taken individually or in combination, fail to teach or suggest claimed method of coating a plastic part. Panush discloses a coating composition comprising: a primer layer; a base coat; and a top coat, which contain a color pigment such as isoindolinone (see page 6, lines 1-3 and 15- 18; Table 1; claim 3). As shown in the table, Panush discloses a pigment amount and a thickness of the topcoat and the base coat, however, Panush does not disclose the pigment amount and the thickness of the primary layer. While Applicants acknowledge the PTO's statements regarding optimization of result effective variables and regarding concentration ranges, the PTO (1) has not yet established that the art recognizes the recited variables as being cause-effective and (2) has not established that the end point of any optimization would lead to the presently claimed ranges, as opposed to, for example, away from the presently claimed ranges. 2 This also means that the PTO has failed to establish that the art suggests the desirability of the presently claimed invention. Thus, Applicants submit that the PTO's reliance on optimization of a cause-effective variable is improper and ought to be withdrawn.

The Examiner respectfully disagrees with this argument. As was discussed paragraph 5 of the Office Action mailed on 5/11/2007, Panush discloses that the primer provides the **primary hiding** and the base color for *less-than-hiding* base coat (See page 6, line s 15-16). Panush also discloses that the amount of pigment blended with the base coat within 1-20 wt % (See page 3,

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lines 11-12) is *sufficient* to produce substrate hiding at 0.5 mils film (claimed more than 30 microns) thickness (See page 21, lines 19-22). The colored primer/basecoat/clear coat system may be made to provide **absolute** substrate hiding (See page 31, lines 1-32).

Therefore, one of ordinary skill in the art would easily understand from Panush that:

- (i) the hiding power of a film depends on amount of a pigment and a thickness of the film, i.e. the amount of a pigment and a thickness of the film are cause-effective variables;
- (ii) the primer that provides the *primary hiding* should have at least 1-20 wt % of a pigment and 0.5 mils thickness that contains in *less-than-hiding* base coat.

In other words, the PTO has established that the art suggests the *desirability* of using a *primary hiding* primer having at least 1-20 wt % of a pigment and 0.5 mils thickness to provide **absolute** substrate hiding.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy, Ph.D.  
Primary Examiner  
Art Unit 1762

ELENA TSOY  
PRIMARY EXAMINER  
*E Tsoy*

September 13, 2007